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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,973	10/05/2001	Kimberly K. Read	10013080-1	3215

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER	
VAUGHN, GREGORY J	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/970,973	READ, KIMBERLY K.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Application History

1. This action is responsive to applicant's submission of a response and declaration under 37 C.F.R. 1.131, filed on 11/12/2004, to the original application filed 10/5/2001.

2. Claims 1-12 are pending in the case, claims 1 and 8 are independent claims.

3. Claims 1, 4, 5, and 8-10 remain rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. US Patent Application Publication 2003/0028399, filed 9/24/2001, published 2/6/2003 (hereinafter Davis). This rejection is restated below.

4. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Davis. This rejection is restated below.

5. Claims 3, 7 and 12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in View of Gorman et al. US Patent Application Publication 2003/0023641, filed 7/27/2001, published 1/30/2003 (hereinafter Gorman). This rejection is restated below.

6. Claims 6 and 11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in View of Schaefer et al. US Patent Application Publication 2001/0052022, filed 4/10/2001, published 12/13/2001 (hereinafter Schaefer). This rejection is restated below.

Response to Declaration Under 37 C.F.R. 1.131

7. The applicant's declaration filed 11/12/2004 under 37 C.F.R. 1.131 has been considered but is ineffective to overcome the effective filing date of the Davis reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Davis reference, up to the date of constructive reduction to practice (i.e. filing date of application serial number 09/970,973).

Regarding the format of said declaration, applicant has failed to provide a clear response for consideration. Specifically, said declaration purports to contain 4 exhibits, but then fails to specify where in the declaration the exhibits can be found. The exhibits fail to be identified with titles or section headings. Furthermore, the declaration contains several sections, but some sections have titles and page numbers where other sections do not. For purposes of considering the declaration, the examiner has added page numbers to the entire declaration, and has made the following section determinations: the Response begins on page 1, the first declaration begins on page 4, exhibit 1 begins on page 9, exhibit 2 begins on page 15, exhibit 3 begins on page 38, and exhibit 4 begins on page 39.

On pages 6-7 of said declaration, applicant declares conception and reduction to practice of her invention prior to September 24, 2001. Applicant also declares to have prepared, signed and submitted an invention disclosure

(exhibit 1) to her employer prior to September 24, 2001. Applicant further declares to have received a draft of the patent application (exhibit 2) with a commentary letter (exhibit 3) from the attorney prior to September 24, 2001. Applicant also declares to have executed the Declaration/Power of Attorney (exhibit 4) on September 12, 2001. On pages 4, 5 and 8, applicant's attorney and senior counsel declare facts supporting inventor's statements.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Davis reference to either a constructive reduction to practice or an actual reduction to practice.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964). See MPEP 715.07.

Under 37 CFR 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a

United States patent application). Note, therefore, that only diligence before reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" is not relevant to an affidavit or declaration under 37 CFR 1.131. See Ex parte Merz, 75 USPQ 296 (Bd. App. 1947). See MPEP 715.07(b).

Also, please note that an applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). See MPEP 2138.06.

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958). See MPEP 2138.06.

Also, please note the diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. See MPEP 2138.06 for the nature of the showing that the attorney must make.

In view of the patent examination rules and procedures described above, the presented combination of evidence within the declarations and exhibits 1-4 are insufficient proof that applicant's invention was diligently reduced to practice before the filing date of the Davis reference, and prior to the filing date of applicant's invention.

Specifically, the declaration fails to provide facts or data applicant is relying on to show completion of her invention prior to the Davis reference.

Furthermore, the declaration fails to describe the period of diligence in terms of either affirmative acts or acceptable excuses. The declaration appears to be relying on the invention disclosure (exhibit 1), the draft application (exhibit 2), the commentary letter (exhibit 3), or the executed the Declaration/Power of Attorney (exhibit 4) to support the period of diligence of the claimed invention. On page 6, paragraphs 2-5 of the declaration, the applicant recites:

> *"2. Prior to September 24, 2001, I conceived the idea of a data driven web page generator, as described and claimed in the *973 application.*
>
> *3. Prior to September 24, 2001, 1 prepared, signed, and submitted an invention disclosure describing my idea (Exhibit 1) to my employer.*
>
> *4. Prior to September 24, 2001, my employer's 'outside counsel, patent attorney, Mr. Randy A. Noranbrock, forwarded to me a draft of the patent application (Exhibit 2) with his commentary letter (Exhibit 3).*
>
> *5. On September 12, 2001, I reviewed the forwarded draft patent application, executed the Declaration/Power of Attorney previously provided as part of Exhibit 2, and returned a signed copy of same (Exhibit 4) to Mr. Noranbrock."*

Note that these general statements fail to provide any explanation as to how the exhibits support the claimed invention. These statements are "broad statements ..." and thus amount to mere pleading. Applicant has not carried the burden of showing facts or data applicant is relying on to show completion of her invention prior to the Davis reference.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *"A person shall be entitled to a patent unless –*
>
> *(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

9. Claims 1, 4, 5, 8-10 remain rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. US Patent Application Publication 2003/0028399, filed 9/24/2001, published 2/6/2003 (hereinafter Davis).

10. **Regarding independent claim 1**, Davis anticipates the preamble. Davis recites: "*FIG. 2 shows an embodiment of an internet web page 50 that is a part of the Patient's Module in accordance with the present invention. Referenced by the trademark "Personal Medpage.TM., this portion of the Patient's Module 30 consists of a data driven web page 50 constructed for and customized to a specific patient*" (page 5, paragraph 86).

Regarding the first limitation to the claim, Davis discloses a screen for receiving attribute category information in Figure 20 at reference signs 240 (where the category is shown as "*Pager/PCS Phone Carriers*"). Regarding the

second limitation to the claim, Davis discloses a screen for receiving attribute group information in Figure 21 at reference sign 302 (where the group is shown as "*Information for email templates, message notification and electronic consultations*"). Regarding the third limitation of the claim, Davis discloses receiving attribute information in Figure 23 at reference sign 342 (shown as attributes "*Blood Pressure*", "*FOSAMAX*" for the group "*Preferences*").

Regarding the fourth limitation to the claim, Davis discloses receiving attribute to attribute group association information in Figure 26 at reference sign 408 (shown as the "*Disease State*" category which is associated by the user to the pull down list box shown to the right of the category name). Regarding the fifth limitation to the claim, Davis discloses a data driven web in Figure 2.

11. **Regarding dependent claims 4 and 5**, the claims remain rejected for fully incorporating the deficiencies of their base claims.

12. **Regarding independent claim 8**, the claim is directed toward a computer system for the method of claim 1, and remains rejected using the same rationale.

13. **Regarding dependent claims 9 and 10**, the claims remain rejected for fully incorporating the deficiencies of their base claims.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."*

15. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Davis.

16. **Regarding dependent claim 2**, Davis discloses a data driven web page with four screens with a first screen for receiving attribute category information attribute as described above. Davis fails to disclose the first screen receiving a column specification. However, Davis discloses a screen related to the first screen that receives the column specification, in figure 27 at reference sign 407b (the right hand column receives the specification).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to use a column specification for the attribute category information, in order to produce a "*web-based (web page) interface provides the patient with a customized and personalized web page*" (Davis, page 9, paragraph 107).

17. Claims 3, 7 and 12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in View of Gorman et al. US Patent Application

Publication 2003/0023641, filed 7/27/2001, published 1/30/2003 (hereinafter Gorman).

18. **Regarding dependent claim 3**, Davis discloses a data driven web page with four screens with a first screen for receiving attribute category information attribute as described above. Davis fails to disclose a column specification that includes the number of columns and column orientation. Gorman discloses a column specification that includes the number of columns and column orientation. Gorman discloses in Figure 2 at reference sign 204 a column specification (shown as "*Column*") and a column orientation (shown as "*Column Span*").

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to combine the data driven web page of Davis with the column specification as taught by Gorman to "*permit non-programmers to create complex input forms without learning web development programming languages*" (Gorman, Page 1, paragraph 10)

19. **Regarding dependent claim 7**, Davis discloses a data driven web page with four screens that receive attribute-to-attribute group associations as described above. Davis fails to disclose the information as group, attribute, attribute order and default value. Gorman discloses the information as group, (shown in Figure 2 at reference sign 102 as "*Shape*"), attribute (shown in Figure 2 reference sign 206 as "*Circle*"), attribute order (shown in Figure 2 at

reference sign 204 as "*row*") and default value (shown in Figure 7 at reference sign 208 as "*Value – The Default Value*").

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to combine the data driven web page of Davis with the group association information as taught by Gorman to "*permit non-programmers to create complex input forms without learning web development programming languages*" (Gorman, Page 1, paragraph 10)

20. **Regarding dependent claim 12**, the claim is directed toward a computer system for the method of claim 7, and remains rejected using the same rationale.

21. Claims 6 and 11 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in View of Schaefer et al. US Patent Application Publication 2001/0052022, filed 4/10/2001, published 12/13/2001 (hereinafter Schaefer).

22. **Regarding dependent claim 6**, Davis discloses a data driven web page with four screens that receive attribute information as described above. Davis fails to disclose the attribute information as attribute ID, attribute type and attribute name. Schaefer discloses attribute information as attribute ID, attribute type and attribute name. Schaefer discloses in Figure 9 the structure of a referenced attribute with a ID, type and name (shown as "*Picture*" under the "*Attribute*" heading).

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to combine the data driven web page of Davis with the attribute information as taught by Schaefer so that "Information should be presented in a unified way, so that control of the system becomes intuitively soon" (Schaefer, Page 1, paragraph 3).

23. **Regarding dependent claim 11**, the claim is directed toward a computer system for the method of claim 6, and remains rejected using the same rationale.

Response to Remarks

24. Applicant's remarks filed 11/12/2004 have been fully considered but they are not persuasive. Applicant's remarks are primarily directed toward nullifying the Davis reference in light of the declaration made under 37 C.F.R. 1.131. The declaration is insufficient proof of applicant's diligence of reduction to practice of her invention, as described above. The rejections of claims 1-12 are maintained, as described above.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
March 15, 2005

STEPHEN HONG
SUPERVISORY PATENT EXA